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25189	7590	12/20/2004	EXAMINER	
CISLO & THOMAS, LLP			BECKER, SHAWN M	
233 WILSHIRE BLVD			ART UNIT	
SUITE 900			PAPER NUMBER	
SANTA MONICA, CA 90401-1211			2173	

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,969

Applicant(s)

BURKE, GARRETT

Examiner

Shawn M. Becker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/10/01</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claims 6 and 18 objected to because of the following informalities: the word "and" should be inserted after --said second clear portion; -- in line 5 of the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 17, and 32 all state "said partial overlay data generally maintaining legibility of the display data", wherein the term "generally" is vague and does not clearly define the scope of the claims.

4. Claim 1 recites the limitation "said clear portion" in line 9 of the claim. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 12 recites the limitation "said highlighted portion" in line 5 of the claim. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 17 recites the limitation "said clear portion" in line 21 of the claim. There is insufficient antecedent basis for this limitation in the claim.

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7. Claim 17 recites the limitation "said highlighted portion" in line 34 of the claim. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 31 recites the limitation "said highlighted portion" in line 7 of the claim. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 32 recites the limitation "said clear portion" in line 25 of the claim. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 33 recites the limitation "said highlighted portion" in line 36 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-8, 10-15, 19-28, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,335,730 to Gould (hereinafter Gould) and U.S. Patent No. 6,803,930 to Simonson (hereinafter Simonson).

Referring to claim 1, 19, 21 Gould teaches a highlighter for electronic text displayed via video memory storing display data and a method, comprising;

a generator, the generator providing obscure (i.e. shrinking) data for use in conjunction with the display data, the data serving to make partially obscure a first portion of display data when the display data is displayed, the obscured data generally maintaining legibility of the

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display data (i.e. smaller, yet legible), the data indicating a second portion of the display data that is not made partially obscure by the obscuring/shrinking data; whereby

the second clear portion is made more prominent (magnified) by contrast with the first, more obscure portion to more easily direct a viewer's eye to a second clear (larger sized) portion. See col. 1, line 63 – col. 2, line 26, which describes how marked data is made more prominent by shrinking the less significant data.

Gould teaches using a shrinking method to obscure the less significant data (first portion), and does not explicitly teach making the less significant data (first portion) partially opaque. However, Simonson teaches making less significant data (old content) obscure/partially opaque by overlaying the data with a tint, such that the text is still legible, but differentiated from the second clear data (new content). See Simonson at col. 5, lines 19-34 and col. 8, lines 64-67. It would have been obvious to one of ordinary skill in the art to utilize the tinting (making partially opaque) method of Simonson instead of the shrinking method of Gould such that a user may easily read through a document and locate particular content with no interruptions of the user's train of thought as supported by Simonson 5, lines 57-65.

Referring to claims 2 and 20, the first portion made opaque/obscure within Gould lies on opposite sides of said second portion. See Fig. 11, which shows obscured text above and below the clear text (61).

Referring to claims 3 and 23, the overlay generator (relativity controller) of Gould is a software application affecting the display data. See col. 7, lines 20-37, which describes the relativity controller as an application program.

Referring to claims 4 and 24, Gould discloses at least one adjustment available to the viewer of the display data. See col. 7, lines 10-19.

Referring to claims 5-6 and 25-26, Gould and Simonson, *supra*, teach that the adjustment is selected from the group consisting of:

A width adjustment that adjusts the width of the second clear portion (i.e. changes the scale of the display; col. 7, lines 12-15 and 50-57);

An opacity adjustment that adjusts a degree of opacity (shading) of the first opaque/obscure portion (Simonson at col. 9, lines 33-50);

A position adjustment that adjusts the position of the second clear portion (i.e. marks another section of text; Gould at col. 7, lines 27-35 and col. 10, lines 10-21); and

A color adjustment that adjusts a color of the first opaque/obscure portion (Gould at col. 7, lines 15-19 and Simonson at col. 9, lines 40-45).

Referring to claims 7 and 27, Gould teaches that the overlay generator enables scrolling of the display data beneath said first and second overlay portions to highlight other portions of a document associated with the display data. See col. 3, lines 62-65 and col. 5, line 65 – col. 6, line 29.

Referring to claims 8 and 28, Gould teaches the overlay generator enables movement of said second clear portion (i.e. an object) associate with movement of a cursor. See col. 3, lines 32-38 and lines 49-53.

Referring to claims 10 and 30, the overlay generator of Gould further comprises:

a bookmark utility (marking utility), the bookmark utility including a bookmark database, said bookmark database having an entry indicating a point of interest in a document for display

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in conjunction with said overlay generator. See Fig. 11 and col. 5, lines 65 – col. 6, lines 27, which shows how the stored marks (bookmarks) are displayed within both the scroll bar and text of the window. Also, refer to col. 8, lines 55-60, which disclose that the marks (bookmarks) are saved with the document.

Referring to claims 11, the bookmark utility of Gould further comprises:

a bookmark control utility, said bookmark control utility having operations selected from the group consisting of bookmark creation (i.e. col. 10, lines 10-21), retrieval (i.e. col. 6, lines 18-28), editing, and deletion utilities (i.e. col. 7, lines 26-40).

Referring to claims 12, the bookmark creation utility of Gould further comprises:

the bookmark creation utility creates a first bookmark for entry into the bookmark database by indicating a portion of a displayed document (i.e. highlighting text with the mouse) and entering information associated with the highlighted portion of the displayed document into said bookmark database. See col. 10, lines 10-21.

Referring to claims 13, the bookmark retrieval utility of Gould retrieving a second bookmark (i.e. Fig. 11, 65) from the bookmark database, retrieves and opens a document associated with the second bookmark (i.e. the document in Fig. 11 is open and associated with the second bookmark), and positions said second bookmark for display in said second clear portion of the display data. See how the second bookmark is displayed in the second window of Fig. 11.

Referring to claims 14, the bookmark retrieval utility of Gould further comprises:

the bookmark retrieval utility indicating a portion of said opened document originally indicated (i.e. highlighted lines 61 and 65) when the second bookmark was created.

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Referring to claims 15, Gould teaches that the bookmark retrieval utility further comprises:

a list of bookmarks present in the bookmark database (i.e. via the markings within the scrollbar that indicate where each mark is in relation to the screen); and

indicated text associated with a particular one of the bookmarks in said list (i.e. highlighted text 61 which is associated with marking 70).

13. Claims 9 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gould, Simonson, and Examiners Automated Search Tool (hereinafter East) as supported by the attached screenshots.

Referring to claims 9 and 29, Gould and Simonson teach distinguishing parts of text from other parts of text in a variety of ways (i.e. changing size (Gould at col. 2, lines 12-21), background, foreground, or a combination thereof (Simonson at col. 8, lines 10-15), but Gould and Simonson do not explicitly teach transposing the second clear portion with the first opaque portion and the first opaque portion with the second clear portion. However, East provides a function for inverting colors, such that the opaque/dark items in the display and the lighter white items in the display are inverted (transposed). See screenshot 2. It would have been obvious to one of ordinary skill in the art to provide such a transposition function as seen in East in the highlighting method of Gould and Simonson in order to allow the user to choose which view is most aesthetically pleasing to their eyes as supported by East.

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14. Claims 16 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gould, Simonson, and U.S. Patent No. 5,506,951 to Ishikawa (hereinafter Ishikawa).

Referring to claim 16, Gould and Simonson do not teach displaying the indicated text when the particular one bookmark is indicated for possible selection. However, Ishikawa teaches a method of referencing locations within a text document, similar to Gould and Simonson, which utilizes jump tags to jump to a referenced location. See col. 2, lines 26-55. The jump tags are displayed within the scroll bar just as the reference markers are displayed in the scroll bar of Gould. See Ishikawa at Fig. 3a. Furthermore, the jump tags indicate possible bookmarked selections and may indicate text that is displayed with the tag. See Fig. 3a, 305b, as an example. It would have been obvious to one of ordinary skill in the art to modify the highlighting/reference method of Gould and Simonson to display indicated text when a bookmark is indicated for possible selection as shown in Ishikawa in order to distinguish which marks (bookmarks) are associated with which text, and quickly navigate to the desired location within the document as supported by Ishikawa.

Referring to claim 31, the bookmark utility of Gould further comprises:

a bookmark control utility, said bookmark control utility having operations selected from the group consisting of bookmark creation (i.e. col. 10, lines 10-21), retrieval (i.e. col. 6, lines 18-28), editing, and deletion utilities (i.e. col. 7, lines 26-40).

The bookmark creation utility of Gould further comprises:

the bookmark creation utility creates a first bookmark for entry into the bookmark database by indicating a portion of a displayed document (i.e. highlighting text with the mouse)

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and entering information associated with the highlighted portion of the displayed document into said bookmark database. See col. 10, lines 10-21.

The bookmark retrieval utility of Gould retrieving a second bookmark (i.e. Fig. 11, 65) from the bookmark database, retrieves and opens a document associated with the second bookmark (i.e. the document in Fig. 11 is open and associated with the second bookmark), and positions said second bookmark for display in said second clear portion of the display data. See how the second bookmark is displayed in the second window of Fig. 11.

The bookmark retrieval utility of Gould further comprises:

the bookmark retrieval utility indicating a portion of said opened document originally indicated (i.e. highlighted lines 61 and 65) when the second bookmark was created.

Gould teaches that the bookmark retrieval utility further comprises:

a list of bookmarks present in the bookmark database (i.e. via the markings within the scrollbar that indicate where each mark is in relation to the screen); and

indicated text associated with a particular one of the bookmarks in said list (i.e. highlighted text 61 which is associated with marking 70).

Gould and Simonson do not teach displaying the indicated text when the particular one bookmark is indicated for possible selection. However, Ishikawa teaches a method of referencing locations within a text document, similar to Gould and Simonson, which utilizes jump tags to jump to a referenced location. See col. 2, lines 26-55. The jump tags are displayed within the scroll bar just as the reference markers are displayed in the scroll bar of Gould. See Ishikawa at Fig. 3a. Furthermore, the jump tags indicate possible bookmarked selections and may indicate text that is displayed with the tag. See Fig. 3a, 305b, as an example. It would have

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been obvious to one of ordinary skill in the art to modify the highlighting/reference method of Gould and Simonson to display indicated text when a bookmark is indicated for possible selection as shown in Ishikawa in order to distinguish which marks (bookmarks) are associated with which text, and quickly navigate to the desired location within the document as supported by Ishikawa.

15. Claims 17-18 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gould, Simonson, East, Ishikawa.

Referring to claims 17-18 and 32-33, Gould teaches a highlighter for electronic text displayed via video memory storing display data and a method, comprising;

a generator, the generator providing obscure (i.e. shrinking) data for use in conjunction with the display data, the data serving to make partially obscure a first portion of display data when the display data is displayed, the obscured data generally maintaining legibility of the display data (i.e. smaller, yet legible), the data indicating a second portion of the display data that is not made partially obscure by the obscuring/shrinking data; whereby

the second clear portion is made more prominent (magnified) by contrast with the first, more obscure portion to more easily direct a viewer's eye to a second clear (larger sized) portion. See col. 1, line 63 – col. 2, line 26, which describes how marked data is made more prominent by shrinking the less significant data.

Gould teaches using a shrinking method to obscure the less significant data (first portion), and does not explicitly teach making the less significant data (first portion) partially opaque. However, Simonson teaches making less significant data (old content) obscure/partially opaque

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by overlaying the data with a tint, such that the text is still legible, but differentiated from the second clear data (new content). See Simonson at col. 5, lines 19-34 and col. 8, lines 64-67. It would have been obvious to one of ordinary skill in the art to utilize the tinting (making partially opaque) method of Simonson instead of the shrinking method of Gould such that a user may easily read through a document and locate particular content with no interruptions of the user's train of thought as supported by Simonson 5, lines 57-65.

The first portion made opaque/obscure within Gould lies on opposite sides of said second portion. See Fig. 11, which shows obscured text above and below the clear text (61).

Gould and Simonson, *supra*, teach that the adjustment is selected from the group consisting of:

A width adjustment that adjusts the width of the second clear portion (i.e. changes the scale of the display; col. 7, lines 12-15 and 50-57);

An opacity adjustment that adjusts a degree of opacity (shading) of the first opaque/obscure portion (Simonson at col. 9, lines 33-50);

A position adjustment that adjusts the position of the second clear portion (i.e. marks another section of text; Gould at col. 7, lines 27-35 and col. 10, lines 10-21); and

A color adjustment that adjusts a color of the first opaque/obscure portion (Gould at col. 7, lines 15-19 and Simonson at col. 9, lines 40-45).

Gould teaches that the overlay generator enables scrolling of the display data beneath said first and second overlay portions to highlight other portions of a document associated with the display data. See col. 3, lines 62-65 and col. 5, line 65 – col. 6, line 29.

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Gould teaches the overlay generator enables movement of said second clear portion (i.e. an object) associate with movement of a cursor. See col. 3, lines 32-38 and lines 49-53.

Gould and Simonson teach distinguishing parts of text from other parts of text in a variety of ways (i.e. changing size (Gould at col. 2, lines 12-21), background, foreground, or a combination thereof (Simonson at col. 8, lines 10-15), but Gould and Simonson do not explicitly teach transposing the second clear portion with the first opaque portion and the first opaque portion with the second clear portion. However, East provides a function for inverting colors, such that the opaque/dark items in the display and the lighter white items in the display are inverted (transposed). See screenshot 2. It would have been obvious to one of ordinary skill in the art to provide such a transposition function as seen in East in the highlighting method of Gould and Simonson in order to allow the user to choose which view is most aesthetically pleasing to their eyes as supported by East.

The overlay generator of Gould further comprises:

a bookmark utility (marking utility), the bookmark utility including a bookmark database, said bookmark database having an entry indicating a point of interest in a document for display in conjunction with said overlay generator. See Fig. 11 and col. 5, lines 65 – col. 6, lines 27, which shows how the stored marks (bookmarks) are displayed within both the scroll bar and text of the window. Also, refer to col. 8, lines 55-60, which disclose that the marks (bookmarks) are saved with the document.

The bookmark utility of Gould further comprises:

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a bookmark control utility, said bookmark control utility having operations selected from the group consisting of bookmark creation (i.e. col. 10, lines 10-21), retrieval (i.e. col. 6, lines 18-28), editing, and deletion utilities (i.e. col. 7, lines 26-40).

The bookmark creation utility of Gould further comprises:

the bookmark creation utility creates a first bookmark for entry into the bookmark database by indicating a portion of a displayed document (i.e. highlighting text with the mouse) and entering information associated with the highlighted portion of the displayed document into said bookmark database. See col. 10, lines 10-21.

The bookmark retrieval utility of Gould retrieving a second bookmark (i.e. Fig. 11, 65) from the bookmark database, retrieves and opens a document associated with the second bookmark (i.e. the document in Fig. 11 is open and associated with the second bookmark), and positions said second bookmark for display in said second clear portion of the display data. See how the second bookmark is displayed in the second window of Fig. 11.

The bookmark retrieval utility of Gould further comprises:

the bookmark retrieval utility indicating a portion of said opened document originally indicated (i.e. highlighted lines 61 and 65) when the second bookmark was created.

Gould teaches that the bookmark retrieval utility further comprises:

a list of bookmarks present in the bookmark database (i.e. via the markings within the scrollbar that indicate where each mark is in relation to the screen); and

indicated text associated with a particular one of the bookmarks in said list (i.e. highlighted text 61 which is associated with marking 70).

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Gould, Simonson, and East do not teach displaying the indicated text when the particular one bookmark is indicated for possible selection. However, Ishikawa teaches a method of referencing locations within a text document, similar to Gould and Simonson, which utilizes jump tags to jump to a referenced location. See col. 2, lines 26-55. The jump tags are displayed within the scroll bar just as the reference markers are displayed in the scroll bar of Gould. See Ishikawa at Fig. 3a. Furthermore, the jump tags indicate possible bookmarked selections and may indicate text that is displayed with the tag. See Fig. 3a, 305b, as an example. It would have been obvious to one of ordinary skill in the art to modify the highlighting/reference method of Gould, Simonson, and East to display indicated text when a bookmark is indicated for possible selection as shown in Ishikawa in order to distinguish which marks (bookmarks) are associated with which text, and quickly navigate to the desired location within the document as supported by Ishikawa.

Conclusion

16. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach methods of highlighting text and utilizing opacity and transparency.

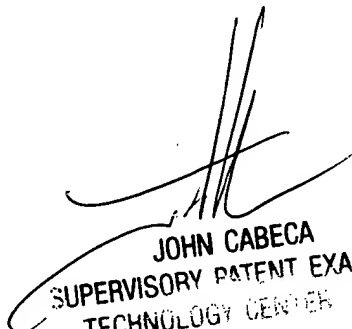
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawn M. Becker whose telephone number is (571) 272-4046. The examiner can normally be reached on M-F 8:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Cabeca can be reached on (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smb



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